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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/490,529	01/25/2000	Thomas K. Roslak	A31598-A-A-072797.0121	7245

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EXAMINER

NGUYEN, CUONG H

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 12/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/490,529

Applicant(s)
Roslak et al.

Examiner
Cuong H. Nguyen

Art Unit
3625



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Jul 10, 2000

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-38 is/are pending in the applica

4a) Of the above, claim(s) _____ is/are withdrawn from considera

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-22 and 29-38 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☒ Claims 23-28 are subject to restriction and/or election requirem

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2

20) ☐ Other:

DETAILED ACTION

1. This Office Action is the answer to the Change of Address request received on 7/10/2001, which paper has been placed of record.
2. Claims 1-38 are pending in this application. This claimed invention is directed to a utility subject matter, not a design patent application; therefore, the examiner submits that examining of this pending application according to the rules set forth for a utility patent.

Drawings

3. This application has been filed with informal drawings, and they are required to be corrected as indications by the draftsman.

Double Patenting

4. A rejection based on provisional double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain **a patent** therefore ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. The non-statutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper time-wise extension of the "right to exclude" granted by a

patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ 2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

Where the claims of an application are not the "same" as those of a first patent, but the grant of a patent with the claims in the application would unjustly extend the rights granted by the first patent, a provisional double-patenting rejection under non-statutory grounds is proper.

5. Claims 1-6, 9-11, 18 have similar claimed limitations over US Pat. Application # 09/232,142 or US Pat. 6,101,483 of same inventors, for similar drawings and claims 1-55 and 69-80, representing similar scope and subject matters of previous invention, and the pending application.

A. Re. To claim 1 of this pending application: The examiner submits that it obviously contains similar limitations as claim 1 of US patent application 09/232,142 or claim 1 of US Pat. 6,101,483.

B. Re. To claim 2 of this pending application: The examiner submits that it obviously contains similar limitations as claims 7, 54 of pending US patent application 09/232,142.

- C. Re. To claim 3 of this pending application: The examiner submits that it obviously contains similar limitations as claim 64 of pending US patent application 09/232,142.
- D. Re. To claim 4 of this pending application: The examiner submits that it contains similar limitations as claim 8 of pending US patent application 09/232,142.
- E. Re. To claim 5 of this pending application: The examiner submits that it contains similar limitations as claim 6 of pending US patent application 09/232,142.
- F.Re. To claim 6 of this pending application: The examiner submits that it obviously contains similar limitations as claim 28 of US patent 6,101,483.
- G.Re. To claim 9 of this pending application: The examiner submits that it obviously contains similar limitations as claim 21 of pending US patent application 09/232,142.
- H. Re. To claim 10 of this pending application: The examiner submits that it obviously contains similar limitations as claim 21 of pending US patent application 09/232,142.
- I.Re. To claim 11 of this pending application: The examiner submits that it contains similar limitations as claim(s) 1/78 of pending US patent application 09/232,142 (the examiner submits that a scanner comprising a wearable

computer processor and a wearable scanner were originally disclosed as "portable" scanner system; and this meanings covers "wearable" terms).

J.Re. To claim 18 of this pending application: The examiner submits that it contains similar limitations as claim 1 of pending US patent 6,101,483.

Restriction/Election

6. The examiner submits that group I contains: claims 1-19, 23-27 for a subject matter of "A personal shopping system (or a shopping method) for servicing customer at shopping establishment and remote locations over a communication network" with US classification: 705/26.

- group II contains claims 20-22, 28-38 for a subject matter involving a portable system using a scanner for communications with US classification: 235/462.01

These groups create 2 separate inventions as defined by above distinguished US class.

An election for one of above 2 groups of claims is requested. For this current Office Action, Group I is assumed to reflect more of the scope and the subject matter of this invention; therefore Group I's claims are analyzed herein.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7.A. Claim **21** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is directed to a wearable scanning system, but an important characteristic of that system of scanning what object is not disclosed. This claim is vague and unclear for that reason.

B. Re. To claim 23: It lacks an antecedent basis for "the system having a point-of-sale..." in line 3 of claim 23, page 116.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

8. Claims **1, 7-8, 13-14** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kolawa** et al. (US Pat. 6,236,974) .

A.Re. To claim 1: **Kolawa** et al. suggest an analogous computer system and analogous remote terminals over a communication network, comprising:

- a terminal/computer system, see **Kolawa** et al., "These three systems are store servers, a remote control system, and information servers.";

- a remotely located terminal, see **Kolawa** et al. "For instance, the preference vectors may be stored at an offside server along with a unique ID. When access to a particular preference vector is desired,"; and

- a centrally server/controller for communicating with said terminal/computer system and said remote terminal via a network, see **Kolawa** et al., "In general, store servers are implemented as computers that are connected to the network. The request for the sale of products is received through the connection. The request is then analyzed and compared to the database of available products in the store. The products selected are then assembled and prepared for delivery. It is not important how the store server interacts with the store computer system. It can interact through the use of store employees who key-in products to sell or it can interact by having a direct connection to the store computer. The purchased products are then added to the list of products which a delivery service will either

deliver to the home or that will be stored waiting for someone to pick up".

Although **Kolawa et al.**, do not expressly disclose exactly claimed languages, but they suggest an analogous system with components that creating a picture of an environment that is claimed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the configuration in the system of **Kolawa et al.**, because **Kolawa et al.**'s system would provide interactive communications exactly as claimed.

B. Re. To claim 7: The examiner submits that any computer with a LUT and a calculating function storing in its hard drive & its microprocessor would do conversions as claimed.

C. Re. To claim 8: The examiner submits that it is well-known of computer using modems for communication with secured lines; and silent/invisible communications are options that users would turn ON/OFF easily depending on users' desires.

D. Re. To claim 13: The examiner submits that it is well-known of a computer coupled to a camera for monitoring purposes.

E. Re. To claim 14: The examiner submits that it is well-known of a computer's features of local/remote control/communications, e.g. a master computer/controller on